

AppL No. 09/863,224
Reply to Office Action of July 27, 2004

Attorney Docket No. 2000.0563/24061.332
Customer No. 42717

REMARKS

Claim 1 has been amended. Claims 31-33 were previously withdrawn from examination due to a restriction requirement, and have been canceled. Applicants reserve the right to file a divisional application that presents the subject matter of non-elected Claims 31-33 for examination on the merits. Claims 1-30 are currently pending in the application, and Applicants respectfully request reconsideration of the application, as amended.

Transfer of Responsibility

Applicants wish to advise the Examiner that, since issuance of the last Office Action, responsibility for this application has been transferred from the law firm of George O. Salle & Associates to the law firm of Haynes and Boone L.L.P. In due course, Applicants will submit a new power of attorney, along with a revocation of the existing power. In the meantime, the undersigned is acting under the provisions of 37 C.F.R. §1.34.

Allowable Subject Matter

Noted with appreciation is the indication in the Office Action that Claims 23-24 and 27 recite allowable subject matter, and would be allowed if rewritten in independent form. These claims each depend from independent Claim 13, which is believed to be allowable for reasons discussed below. Accordingly, it is believed to be unnecessary to separately place Claims 23-24 and 27 in independent form at this time.

Claims 13-22, 25-26 and 28-30

Claims 13-22, 25-26 and 28-30 stand rejected under 35 U.S.C. §103 as obvious over newly-cited Chen U.S. Patent No. 6,518,166, taken in view of Zhou U.S. Patent No. 6,358,842. This ground of rejection is respectfully traversed, for the following reasons. The Office Action indicates that the Chen patent qualifies as prior art under §102(e), and later makes the rejection

Appl. No. 09/863,224
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under §103 by using Chen in combination with Zhou. However, effective November 29, 1999, the provisions of 35 U.S.C. §103(e) were amended to specify that:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

These provisions from §103(c) apply to applications filed on or after November 29, 1999. These provisions thus apply to the present application, which was filed on May 24, 2001 (or in other words after November 29, 1999). Moreover, the subject matter of the pending claims and the subject matter relied on in the Chen patent were, at the time the subject matter of the pending claims was invented, owned by the same person or subject to an obligation of assignment to the same person (Taiwan Semiconductor Manufacturing Company). It is therefore respectfully submitted that the Chen patent is disqualified as prior art for purposes of §103. See MPEP §§706.02(k) and (l), including for example the first sentence of §706.02(k), which states that:

Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person".

Appl. No. 09/863,224
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Attorney Docket No. 2000.0563/24061.332
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Since the Chen patent thus does not qualify as prior art for purposes of §103, the §103 rejection using Chen and Zhou is based almost completely on material that is not effective prior art under §103 with respect to the present application. This §103 rejection is thus defective, and it is respectfully submitted that it must be withdrawn. Claims 13-22, 25-26 and 28-30 are not subject to any other ground of rejection. It is therefore respectfully submitted that these claims are all allowable. Notice to that effect is respectfully requested.

Independent Claim 1

Claim 1 stands rejected under 35 U.S.C. §102(e) as anticipated by the Chen patent. The PTO specifies in MPEP §2131 that, in order for a reference to anticipate a claim under §102, the reference must teach each and every element recited in the claim. Claim 1 has been amended to include a recitation of:

... providing a substrate ... having a passivation layer disposed on
a side of said first insulative layer opposite from said etch-stop
layer; ...

The Office Action states at line 8 on page 5 that "Chen does not disclose forming a barrier layer". (To avoid confusion, it should be noted that although this sentence from the Office Action refers to a "barrier" layer, the sentence is actually discussing a layer that Applicants refer to as a "passivation" layer, and not a layer that Applicants refer to as a "barrier" layer). As discussed above, Claim 1 has been amended to include a recitation of a passivation layer. Therefore, Claim 1 recites an element that the Office Action admits is not disclosed in Chen. Amended Claim 1 is therefore not anticipated by Chen. Moreover, as discussed earlier in these remarks, the Chen patent does not qualify as prior art with respect to the present application under 35 U.S.C. §103. Consequently, it is respectfully submitted that Claim 1 is not anticipated or rendered obvious by Chen, considered alone or in combination with some other reference,

Appl. No. 09/863,224
Reply to Office Action of July 27, 2004

Attorney Docket No. 2000.0563/24061.332
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because Chen is not prior art under §103. It is thus respectfully submitted that Claim 1 is allowable, and notice to that effect is respectfully requested.

Dependent Claims

Claims 2-12 depend from Claim 1, and are also believed to be distinct from the art of record, for example for the same reasons discussed above with respect to Claim 1.

Conclusion

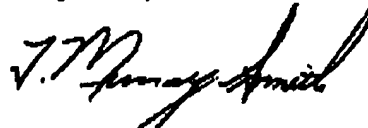
Based on the foregoing, it is respectfully submitted that all of the pending claims are fully allowable, and favorable reconsideration of this application is therefore respectfully requested. If the Examiner believes that examination of the present application may be advanced in any way by a telephone conference, the Examiner is invited to telephone the undersigned attorney at 972-739-8647.

Appl. No. 09/863,224
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Attorney Docket No. 2000.0563/24061.332
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Although Applicants believe that no fees are due in association with the filing of this Response, the Commissioner is hereby authorized to charge any additional fee required by this paper, or to credit any overpayment, to Deposit Account No. 08-1394 of Haynes and Boone LLP.

Respectfully submitted,



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Enclosures: None

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